

## REMARKS

Claims 1 to 10 are pending. Claims 1 and 10 have been amended.

### 35 U.S.C. § 112§, first paragraph

Claims 1 to 7 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. Claim 1 has been amended to specify which types of cancer are encompassed by the scope of the claims. Namely, only those cancers that are responsive to proteasome inhibition. It is well known in the art of cancer treatment that proteasome inhibition provides an effective means for treating cancers that arise via the proteasome pathway. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

### 35 U.S.C. 102 (b)

Claims 8 to 10 stand rejected as allegedly anticipated by WO 01/07407. However, the '407 publication describes and claims compounds that are useful for the treatment of Hepatitis C Virus (HCV). The present invention is directed to methods for treating cancer in a mammal in need of such treatment. Although the Office Action suggests at page 6 that "inhibition of the proteasome" would be inherent, Applicants disagree. The compounds used for treating HCV would not necessarily be given to a patient with cancer, especially a cancer susceptible to proteasome inhibition. Also, the methods for treating HCV would not necessarily be effective for treating a patient with cancer. It is well settled law that inherency "may not be established by probabilities or possibilities." *Continental Can Co. v. Monsanto*, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991). Treating a patient for HCV with the compounds disclosed in the '407 publication could *possibly* treat a cancer is the patient. But the cancer must exist, must be susceptible to proteasome inhibition, and the compounds must be given in an amount sufficient to treat the cancer every time, in order to be inherently disclosed in the publication.


## Double Patenting

Claims 1 and 10 stand provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as claims 27 and 35 of copending Application No. 10/010,184, ('184) which corresponds to the '407 application mentioned previously. Significantly, claim 27 is directed to a compound, while the claims of the present invention are directed to methods for treating cancer and pharmaceutical compositions that are therapeutically effective for reducing tumor growth rates, inducing tumor regression or treating the symptoms of cancer. Because the claims of the present invention in no way overlap with the claims of the '184 application, Applicants request that no double patenting rejection be given.

Applicants believe that the claims are now in condition for allowance. An early Office Action to that effect is therefore earnestly solicited.

Respectfully submitted,

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